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OFFICE OF PETITIONS

In re Application of :
Intrater, et al. :
Application No. 09/234,427 :
Filed: January 20, 1999 :
Attorney Docket No. NSC8-8400 :

ON PETITION

This is a decision on the August 27, 2008 petition filed under 37 CFR 1.183¹ requesting suspension or waiver of the regulations (37 CFR §§ 1.67 and 1.175) that require the inventors to sign any supplemental declaration in a broadening reissue application.

The petition under 37 CFR 1.183 is GRANTED for the reasons stated below.

U.S. Patent No. 5,630,153 issued to Amos Intrater, et al. on May 13, 1997. A broadening reissue application (the present application) was filed on January 20, 1999, and it was assigned application number 09/234,427. On August 27, 2008, applicants filed a petition under 37 CFR 1.183 requesting suspension or waiver of the "regulations pertaining to the filing of a Supplemental Declaration under 37 C.F.R. § 1.175" that require a supplemental reissue declaration to be signed by the joint inventors. The petition is accompanied by a "Supplemental Reissue Declaration," signed by five of the six inventors. It is for this supplemental declaration that the petition requests acceptance, via suspension or waiver of the regulations.

The petition proffers a showing to establish that, despite diligent effort, inventor Maurice Valentaten cannot be found or reached to sign the supplemental reissue declaration. The Mark C. Pickering declaration and the discussion in the petition set forth (a) the efforts made on behalf of the assignee to locate the non-signing inventor and obtain the requisite signature on the supplemental declaration, and (b) the lack of success of such efforts.

35 U.S.C. 251, which is directed to reissue, does not address the signature requirements of a declaration in reissue. 37 CFR 1.172 requires that a reissue declaration be made (and signed) by the inventors, except as otherwise provided (§§ 1.42, 1.43, 1.47), where the scope of the claims of the original patent is being enlarged. 37 CFR § 1.175(b)(1), requires that:

"For any error corrected, which is not covered by the oath or declaration submitted under paragraph (a) of this section, applicant must submit a supplemental oath or declaration

stating that every such error arose without any deceptive intention on the part of the applicant.”

37 CFR 1.175(b)(1), taken in conjunction with 37 CFR 1.172, requires a supplemental declaration to be signed by all inventors. This is because all oaths or declarations necessary to fulfill the rule requirements in a reissue application are taken together collectively as a single oath or declaration. Thus, each oath and/or declaration must bear the appropriate signature of the inventor(s).

37 CFR 1.183 permits, in an extraordinary situation, waiver of a rule which is not a requirement of the statute, where justice requires such waiver, and applicant has requested a waiver of the requirement that the 37 CFR 1.175(b)(1) supplemental declaration be signed by all of the inventor.

The instant petition and supporting declaration of Mark C. Pickering provide an appropriate and sufficient showing that the inventor cannot be reached or found sign the supplemental declaration. Further, a review of the record reveals that the inventor assigned his entire right, title and interest in the application (and the patent for which reissue is requested) to National Semiconductor Corporation by way of an assignment recorded at Reel/Frame 006184/0772 on July 1, 1992. In addition, absent a waiver of the rules, the assignee will be unable to obtain a reissue patent for the instant broadening reissue application, and will be irreparably damaged.

In view thereof, the petition under 38 CFR 1.183 to waive the requirements of 37 CFR 1.67 and 1.175 is hereby GRANTED.

Please direct any questions related to this decision to Petitions Attorney Alesia M. Brown at (571) 272-3205.

/Kenneth M. Schor/

Kenneth M. Schor
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Ken/pet7/reissue

Sept. 11, 2009